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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,463	09/19/2003	John K. Apostolidis	030132	8348
26285	7590	06/16/2008		
KIRKPATRICK & LOCKHART PRESTON GATES ELLIS LLP			EXAMINER	
535 SMITHFIELD STREET			JEANTY, ROMAIN	
PITTSBURGH, PA 15222			ART UNIT	PAPER NUMBER
			3623	
		MAIL DATE	DELIVERY MODE	
		06/16/2008	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/666,463	<b>Applicant(s)</b> APOSTOLIDES, JOHN K.
	<b>Examiner</b> Romain Jeanty	<b>Art Unit</b> 3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on March 28, 2008.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 122 is/are pending in the application.

4a) Of the above claim(s) 118-121 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-117 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/DS/06)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

1. This Non-Final Office action is in response to the communication received on March 28, 2008.

**Election/Restrictions**

2. Applicant's election without traverse of claims 1-117 in the reply filed on March 28, 2008 is acknowledged.

**Information Disclosure Statement**

3. The information disclosure statement (IDS) submitted on November 20, 2003 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

**Claim Rejections - 35 USC § 112**

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 115-117 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 115-117, the claims do not appear to satisfy or to be within any of the statutory classes of invention, namely a useful process, machine, manufacture, or composition of

matter, or any new and useful improvement thereof. Thus, the claims do not tie with a computer system for performing any functions.

#### **Claim Rejections - 35 USC § 101**

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-114 are rejected under 35 U.S.C. 101 as drawn to a non-statutory subject matter. The claims (or at least independent claims 1 and 68) are related to mental processes, which is not patentable. Indeed, the claims (e.g. claim 1) recite a (mental) process, which is not tied to another statutory class or does not change or switch statutory class (such as a particular apparatus) or does not transform the underlying subject matter (such as an article or materials) to a different state or thing. See MPEP §2106.IV.B: *Determine Whether the Claimed Invention Falls Within An Enumerated Statutory Category*. See also the following U.S. Supreme Court cases: *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); and *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

Regarding claims 115-117, the claims do not appear to satisfy or to be within any of the statutory classes of invention, namely a useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof. Thus, the claims do not tie with a computer system for performing any functions.

Based on the 101 and 112, second paragraph, the claims do not fall within any of the statutory classes of invention and appears to vastly differ from the other claims as the scope of these claims cannot be positively ascertained.

### **Claim Rejections - 35 USC § 102**

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-117 are rejected under 35 U.S.C. 102(e) as being anticipated by Hart (Patent No. 7,048,185).

Regarding claim 1, Hart discloses a system for tracking and recording equipment information. In so doing, Hart discloses a service data device configured for displaying at least one data screen including at least one checklist configured for operative use in connection with performance of said service operation on said inspected item, said data device being portable and being configured for processing at least one communication (col. 13, lines 19-50); a service administrator (i.e., a tracking system. Note figure 4) having at least one data storage medium configured for storing at least one of said checklists displayed on said data device (col. 5 line 45 through col. 6 line 17), said service administrator further having at least one server for enabling at least one communication between said service administrator and said data; at least a portion of at least one of said checklists being customizable by at least said service administrator (i.e.

depending on the item serviced or equipment tracked, there must be a specific customized checklist for the specific or item serviced because different types of item serviced or equipment tracked require different types of services) and, at least a portion of at least one of said checklists being electronically interactive in association with performance of said service operation on said inspected item (col. 5 line 45 through col. 6 line 17).

### **Conclusion**

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Manegold (u.s. Patent No. 6,671,646) discloses a portable device for use in recording data related to safety inspection.

b. Casey et al (U.S. Patent No. 6,513,045) provides an automated cross-product process for creating and updating phases of an IS system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Romain Jeanty whose telephone number is (571) 272-6732. The examiner can normally be reached on Mon-Thurs 7:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Van Doren can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3623

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

June 8, 2008

/Romain Jeanty/  
Primary Examiner, Art Unit 3623